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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,977	03/25/2004	Jian Qin	15105.1	9633

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EXAMINER	
STEPHENS, JACQUELINE F	

ART UNIT	PAPER NUMBER
3761	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/810,977	QIN ET AL.	
	Examiner	Art Unit	
	Jacqueline F. Stephens	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JACQUELINE F. STEPHENS
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/8/05 have been fully considered but they are not persuasive. Applicant argues Bashaw is directed to a pulverized superabsorbent material and it is known in the art that the pulverization process results in hydrophilic superabsorbents. Firstly, applicant has not provided support for this statement. Secondly, at some point in the process, the superabsorbent has a hydrophobic surface, which renders the need for a surfactant to disperse the superabsorbent in the cellulosic web. Applicant argues the superabsorbent of the present invention is hydrophobic because it is produced in a spinning process and the process results in a different fiber than the fiber resulting from a pulverization process. Although the specification mentions the surface of a SAF is made hydrophobic during the fiber spinning process, a particular type of web i.e. airlaid, wetlaid, is not claimed, and applicant is relying on features which are not recited in the rejected claims. Additionally, there is no evidence and/or comparison of any unexpected result in terms of the superabsorbent resulting from a pulverization process compared to the superabsorbent formed from a spinning process. The rejection has been made in the sense of In re Thorpe 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted), which states that when the product is claimed the patentability is defined only by the product per se, not by the process of its making and the burden is shifted to Applicants to show that the process of the prior art produces a different product. This should be presented by the factual evidence, and in the instant case the Applicant failed to show a valid side-by-side comparison between

their product and the product disclosed by Bashaw, wherein the only difference is the process of their making, as per In re Dunn, 349 F. 2d 433 146 USPQ 489 (CCPA 1965).

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 22-26, 27, 29-32, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Bashaw et al. USPN 3989586 or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Bashaw et al. USPN 3989586 in view of Howe USPN 5494611.

Regarding the preamble of the independent claims 22, 34, and 37 the phrase "a permanently wettable superabsorbent material made by the method comprising is directed to a method of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113. The claims will be treated for the structural limitations claimed or implied by the recited processes.

As to claims 22, 24-26, 34, and 35, Bashaw discloses a permanently wettable superabsorbent material and method of making the absorbent comprising: treating the superabsorbent material with a surfactant solution (col. 2, lines 9-11;col. 4, lines 35-68). Bashaw discloses the crosslinked copolymer is further activated with methanol, dried and processed in fiber form (col. 4, lines 1-21). The surfactant solution includes an

amount of water sufficient to solvate the surface of the superabsorbent material but less than sufficient to cause significant swelling of the superabsorbent material (col. 4, lines 1-5). Bashaw discloses surfactants (col. 4, lines 35-68) similar to the surfactants taught in the present specification page 6, line 25 through page 7,line 7. In particular, Bashaw discloses cetyl dimethylamine oxide. Howe shows that cetyl dimethylamine oxide is an equivalent structure known in the art of lauryl dimethylamine oxide (Howe col. 4, lines 48-61). Because these two surfactancts are art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute cetyl dimethylamine oxide for lauryl dimethylamine oxide, which applicant discloses is a suitable surfactant having the claimed functional groups.

Regarding the Flotation Time procedure and the Surface Tension Test and the examiner's interpretation of the tests and performance characteristics of the instant apparatus claims, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald,* 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980).

As to claim 23, Bawash discloses the superabsorbent material is a fibrous form (col. 2, lines 6-45).

As to claim 27, see Bashaw col. 2, lines 6-8.

As to claim 29, see Bashaw col. 4, lines 35-68.

As to claim 30, see Bashaw col. 3, lines 57-59 and col. 4, lines 21-29.

As to claim 31, Bashaw see Example 1.

As to claim 32, Bashaw discloses the surfactant is applied to the superabsorbent material when the superabsorbent material is in powder form, which the examiner interprets to be in a solvated state, as the copolymer is solubized in the solvent to form the powdered copolymer (col. 5, lines 23-27).

5. Claims 28, 33, 36, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashaw in view of Howe as applied to claims 22 and 34 above and further in view of Paul et al. USPN 6217890.

As to claim 28, Bashaw/Howe discloses the present invention substantially as claimed. However, Bashaw/Howe does not disclose the claimed group of materials. Paul discloses high absorbency materials in the claimed group as a natural alternative to synthetic high absorbency materials (col. 25, lines 25-40). Therefore, because the natural materials as disclosed in Paul are art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the natural materials for the synthetic material, such as maleic anhydride disclosed in the Bashaw reference.

As to claims 33 and 36, Bashaw/Howe discloses the paper product is highly absorbent (col. 7, lines 18-20). However, Bashaw/Howe does not specifically disclose the fiber in a disposable absorbent product as claimed. Paul discloses a similar treated superabsorbent material for use in a diaper comprising a liquid-permeable topsheet 22, a backsheet 20 attached to the topsheet, and an absorbent structure 24 made with a treated superabsorbent fiber positioned between the topsheet and the backsheet for the benefit of having highly absorbent material in a relatively thin absorbent article (Paul col. 24, line 52 through col. 25, line 52). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the invention of Bashaw/Howe into a disposable absorbent article as claimed, since the invention of Bashaw/Howe provides a highly absorbent article, which both references teach is desired.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacqueline F Stephens
Primary Examiner
Art Unit 3761

February 17, 2006